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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,099	06/09/2005	Masanori Sera	260087US0PCT	6203

22850 7590 11/19/2009

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EXAMINER	
NUTTER, NATHAN M	

ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
11/19/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/511,099	SERA ET AL.	
	Examiner	Art Unit	
	Nathan M. Nutter	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9 and 12-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9 and 12-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 September 2009 has been entered.

Response

In view of the filing of an acceptable Terminal Disclaimer in copending application SN 10/577,496 (US 2007/0079825) Sera et al, the provisional rejection of claims 9 and 12-18 on the ground of nonstatutory obviousness-type double patenting as being unpatentable thereover, is hereby expressly withdrawn.

Declaration

The Declaration of Shinichi Yukimasa filed 17 February 2009 has been considered. The declaration is not deemed to provide any patentable weight to the instant claims. The declaration is drawn to the comparison of resins made with metallocene catalysts and those made with Ziegler-Natta catalysts. No direct comparison has been made with the reference compositions to Abe et al or Iwata et al. The declaration appears to insinuate, without actually stating, that the resins of the

patent documents were produced with Ziegler-Natta catalysts. This has not been shown, either from the documents or from other evidence in support thereof. As such, no true comparison has been presented in the declaration as between the instantly claimed invention and the disclosures of Abe et al (US 5,218,048) or Iwata et al (US 5,430,080).

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9 and 12-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Abe et al (US 5,218,048).

The reference to Abe et al shows the contemplated blend of "a higher α-olefin" polymer which may contain "50 mol% or more" of the monomer. The reference shows the higher alpha olefin homopolymers at column 3 (lines 20-35). The paragraph bridging column 3 to column 4 teaches the use of the thermoplastic resin. Further, note column 3

(lines 56-62) for the molecular weight which would be expected to be within the range of claim 4. As regards the MWD of "4.0 or less" there is no indication that the value would or could be higher than one.

The reference shows the resin blend, as pointed out above. The employment of a stereoregular homopolymer of 1-decene would be within the purview of the reference, absent reasoning as to why it would not be. The molecular weight range and molecular weight distribution would also be expected to be within the ranges recited. A skilled artisan would have a high level of expectation of success following the teachings of the reference to arrive at the instantly claimed invention.

As such, the instant claims are deemed to be at least obvious, if not anticipated, by the teachings of the reference.

Claims 9 and 12-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iwata et al (US 5,430,080).

The reference to Iwata et al teaches the manufacture of a blend composition of a thermoplastic resin that, at the paragraph bridging column 6 to column 7 may includes homopolymer of 1-decene with another thermoplastic resin. Though the reference is not specific as to stereoregularity of the poly(1-decene), such would be within the purview of the reference, absent reasoning as to why it would not be. The molecular weight range and molecular weight distribution would also be expected to be within the ranges recited. Since the higher olefin polymer is identical to that recited herein, the melting point would be expected to embrace that of claim 5. The particular catalyst employed in

the manufacture of the resin fails to provide any patentable weight to the claims since the claims are drawn to a composition. Process claims in a product-by-process situation have been held not to be claim limitations. See *SmithKline Beecham Corp. v. Apotex Corp.*, No. 04-1522 (Fed. Cir. February 24, 2006).

As such, the instant claims are deemed to be at least obvious, if not anticipated, by the teachings of the reference.

Response to Arguments

Applicant's arguments filed 28 September 2009 have been fully considered but they are not persuasive.

With regard to the Declaration of Shinichi Yukimasa filed 17 February 2009, applicants contend "there is no reasonable basis for a skilled artisan to conclude that the α-olefin polymers described in Abe and Iwata would have a stereoregularity index M2 of ≥ 50 mol% and a single melting point Tm of 0°C to 100°C, as claimed in claim 9." Applicants have provided no direct line of reasoning to conclude such. No direct comparison has been provided nor established either through the declaration or other evidence. Applicants refer to "Ziegler-Natta catalysts suffer from inferior properties with respect to decreased film impact resistance and reduced miscibility between the higher α-olefin polymers and the thermoplastic resins," but have not shown that the references possess or do not possess these characteristics since it has not been established that the references employ Ziegler-Natta catalysts. Moreover, the claims are drawn to a product. as such, the steps producing that product are not provided weight in the

determination of patentability. Note ***SmithKline Beecham Corp. v. Apotex Corp.***, (Fed. Cir. February 24, 2006).

With regard to the rejection of claims 9 and 12-18 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Abe et al (US 5,218,048), and the rejection of claims 9 and 12-18 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iwata et al (US 5,430,080), applicants have failed to argue each reference on its own merits. Applicants' continued treatment of the rejections *in combination,* as opposed to for the merits of each, will result in future communications being held non-responsive. Further, the references were not presented in combination.

The claims are drawn to a composition, per se. the manner of preparation of any or all of the constituents does not provide patentable support in a composition claim, even in product-by-process situations, which is not the case here. Since all other parameters are shown other than the stereoregularity index M2 as recited, there appears to be great coincidence that the compositions would possess same. Applicants have failed to differentiate through any comparative data.

Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

It is noted that while applicants argue of the catalyst employed being critical, the catalyst is recited in claims 16 and 17, only, and not in the broad claim 9.

As pointed out before and above, the declaration submitted under 37 CFR 1.132 of Yukimasa on 17 February 2009 is not a direct comparison with either reference composition or resins produced from the teachings contained in each. As such applicants have failed to meet the burden of showing such difference. For example, applicants contend the comparative data obtained and shown in the Declaration "is more closely related to the invention than the prior art relied upon by the Examiner." This has not been shown. No direct comparisons have been made and, in view of the fact that neither reference excludes the use of metallocene catalysts, and the instant claims recite the catalyst in dependent claim, only, Applicants have failed to establish any differences in the compositions of either reference with that claimed herein.

Arguments of record follow.

With regard to the rejection of claims 9 and 12-18 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Abe et al (US 5,218,048), applicants ignore the teachings pointed out by the Examiner as to the monomers. Further, it is submitted that the monomers disclosed at column 3 (lines 19 et seq.) include many as disclosed in the instant Specification at page 14 (lines 6-13) of 10 to 40 carbon atoms, and a polymer, especially a homopolymer produced therefrom would, indeed, have the melting point range recited herein. Nothing on the record would indicate otherwise. As such, the claims are at least obvious, if not anticipated, by the

teachings of the patent. Further, each of applicants' assertions is drawn to "examples," "preferred" or "generally" described and not in reference to the broad teachings of the reference. See, applicants' response, page 13, lines 4, 7, 10, 16, 18, 22, 24, etc.. A reference is viewed in the entirety of its teachings and not for isolated examples or passages therein.

With regard to the rejection of claims 9 and 12-18 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iwata et al (US 5,430,080), again, applicants ignore the teachings pointed out by the Examiner as to the monomers. Further, it is submitted that the poly(1-decene) resin disclosed at column 7 (line 2) would, indeed, have the melting point range recited herein. Nothing on the record would indicate otherwise. As such, the claims are at least obvious, if not anticipated, by the teachings of the patent. Again, each of applicants' assertions is drawn to "examples," "preferred" or "generally" described and not in reference to the broad teachings of the reference. A reference is viewed in the entirety of its teachings and not for isolated examples or passages therein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

16 November 2009